

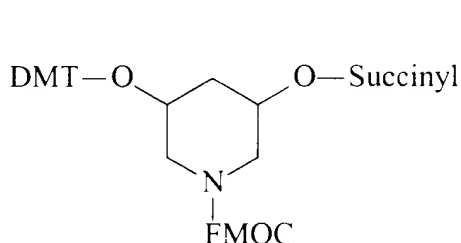
Remarks

Claims 1-26 are pending in this application. Claims 1-26 stand rejected under 35 U.S.C. 112, first paragraph, for alleged lack of enablement. Applicants respectfully traverse the rejection, as the present claims are enabled within the patent laws.

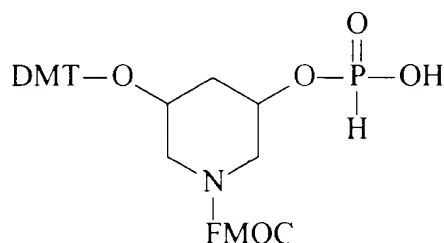
As best understood by Applicant, the Examiner has recognized that synthesis of the oligomeric compounds utilizing the elected structure VI is sufficiently described, but that the invention is not enabled because the specification allegedly fails to describe the synthesis of monomers having structure VI. However, as the Examiner acknowledges, Example 77 teaches the synthesis of a hydroxypiperidine useful in the synthesis of monomers having structure VI. The Office Action appears to suggest that the starting material, N-benzyl-(5R)-O-(t-butyldimethylsilyl)-(3R)-hydroxypiperidine, used in Example 77, is not described and that, therefore, enablement for the preparation of the monomers is lacking. However, Applicant describes the preparation of the starting material as that taught generally by J. Cossy, *et al.* *Tetrahedron Lett.*, 1995, 36, 549, which is cited in the example. The reference to the Cossy publication is sufficient to enable the preparation of such starting material as the art- skilled would have no difficulty practicing the claimed methods once instructed by the specification. Absent some evidence indicating that the art- skilled, having read Applicant's specification, would not be able to practice the claimed inventions, there is no reason to believe that the

"amount of guidance working examples" in the specification is insufficient within the meaning of § 112. *In re Wright*, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993) (when rejecting a claim under the enablement requirement of § 112, the Patent Office bears the "initial burden of setting forth a reasonable explanation as to why [he/she] believes that the scope of protection provided by [the] claim is not adequately enabled by the description of the invention provided in the specification"). A patent application is presumptively enabled when filed.

In brief, Example 77 teaches the preparation (5R)-O-(t-butyldimethylsilyl)-(3R)-hydroxypiperidine; Examples 78 through 80 teach the various protection and deprotection steps necessary to yield N-(Fmoc)-(3R)-O-Dimethoxytrityl-(5R)-hydroxypiperidine; Examples 81 and 82 teach the formation of compounds having structure VI, such as the succinyl and H-phosphonates below:



Example 82



Example 81

and guidance for attaching the aminodiols monomer subunit to a solid support is disclosed in the specification at, for example, in Examples 82, 83, 60 and 61. Accordingly, the preparation of useful monomers is indeed enabled. *See*, MPEP § 2164 (claims are enabled as long as the

DOCKET NO.: ISIS-2297

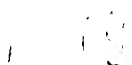
PATENT

information contained in the disclosure is sufficient to inform those skilled in the relevant art how to both make and use the invention).

Applicant believes that the present claims are now in condition for allowance.

An early Office Action to that effect is, therefore, earnestly solicited.

Respectfully submitted,



Maureen S. Gibbons
Registration No. 44,121

Date:

WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS
One Liberty Place - 46th Floor
Philadelphia, PA 19103
(215) 568-3100